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EXAMINER	
WONG, JOSEPH D	

ART UNIT	PAPER NUMBER
2166	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/589,638	TO, YUICHIRO	
	Examiner	Art Unit	
	JOSEPH D. WONG	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20060816*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

Title is objected to as not being descriptive of the specified invention as it recites mostly abstract elements or legal phraseology. A new title is suggested: "Efficient Content Transfer Apparatus".

The abstract is objected to for containing unnecessary legal phraseology pertaining to statutory class "information processing apparatus". Appropriate descriptive correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected for having a less than clear statutory class. The instant claim appears directed towards a hybrid process claim because it recites a program and device and procedure. See MPEP 2173.05(p)(II). Clarification is requested as to how this claim expressly or implicitly could be a program product claim without having the formality of a tangible storage medium.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 and 15 are rejected for being directed towards nonstatutory subject matter.

Claim 1 is directed to an information processing apparatus. However, every element recited within the body of the claim appears directed to software elements such that he claim is reasonably interpreted to consist of software per se rather than at least one physical article. Appropriate correction is required. Claims 2-7 are rejected as being dependent upon claim 1.

Claim 15 is directed to a computer program for carrying out a procedure for transferring contents to an external device. However, the instant claim is loosely interpreted to be directed toward a computer program listing or a computer program per se. Appropriate correction is required.

Applicants can look to MPEP 2106.01-2106.02 (July 2008), Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, Instant Specification, and contemporary case law with a matching fact pattern for further suggestions that may be helpful in overcoming these rejections.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Goodman, (US 6,928,433 B2), hereinafter Goodman.

As to claim 1, Goodman teaches an information processing apparatus comprising: a data storage block which store contents (Fig. 6, "the right kind of track for this branch"); and a data processing block which transfers said contents to an external device (Fig. 9, item 100, see portable device and transfer from Fig. 14, items 302 to 300); wherein said data processing block acquires recorded data including content IDS about the contents already transferred from said information processing apparatus to said external device connected to the apparatus (Figures 8, 10, 12, see album play list and search retrieval queries to populate playlist), said data processing block further comparing the acquired recorded data about the transferred contents with the content IDS of said contents stored in said data storage block in order to determine non-transferred contents which are established as the contents to be transferred to said external device (Fig. 8 corresponds to display seen on Fig. 14, item 304, computer and Fig. 9 corresponds to Fig. 14, item 300, external portable device).

As to claim 2, Goodman teaches the information processing apparatus, wherein said data processing block acquires information about albums including said non-transferred contents so that the contents held in the albums identified by the acquired information (loosely interpreted to be optional) may be established as the contents to be transferred to said external device (Abstract; Figures 8 and 14).

As to claim 3, Goodman teaches the information processing apparatus, wherein said data processing block causes displaying means to display information about albums including said

non-transferred contents and (Col. 1, Lines 35-64 “portable devices have...a compact user interface to navigate and select among hundreds of song...can only show a few song titles at a time"), given a selection of albums from a user in response to the displayed information (Fig. 8, see list of tracks from "album "Meddle" displayed), transfers the contents from the selected albums (see “Track Name” in Fig. 8).

As to claim 4, Goodman teaches the information processing apparatus, wherein said data processing block acquires information about albums having only said non-transferred contents so that the contents held in the albums identified by the acquired information may be established as the contents to be transferred to said external device ([7],"Favorites by Band X").

As to claim 5, Goodman teaches the information processing apparatus, wherein said data processing block causes displaying means to display information about albums having only said non-transferred contents and ([62], “”Stardust does not have any entries for Album or Artist”; Fig. 6, “no...this the right kind of track for this branch?”), given a selection of albums from a user in response to the displayed information (Fig. 10), transfers the contents from the selected albums (Fig. 8, see buttons on top).

As to claim 6, Goodman teaches the information processing apparatus, wherein said data processing block acquires recorded data about said transferred contents from said external device (Col. 1, Lines 25-30, “MP3 and CD players both provide facilities for forming playlists(sic)....allows selection of tracks from the PC’s hard disk”), and compares the acquired recorded data about said transferred contents with the content IDS of said contents stored in said

data storage block in order to determine non-transferred contents (Fig. 12, “Search for Albums...BB...BEST OF BACH").

As to claim 8, Goodman teaches an information processing method for transferring contents to an external device (Fig. 14, item 300), said information processing method comprising the steps of: detecting said external device upon connection thereof (Fig. 14, see lines between items 300 and 302); acquiring recorded data including content IDS about he contents already transferred from an information processing apparatus to said external device (Col. 3, Lines 10-12), “CDDB metadata, id3v2 metadata”; Col. 6, Line 20, “ID3 tags included in the MP3 file” ; Col. 7, Lines 8-9, "TRACK ID”); comparing said recorded data about the transferred contents with the content IDS of said contents stored in a data storage block of said information processing apparatus in order to determine non-transferred contents (Col. 7, Lines 57-64, “edit the file attribute”... on the computer); and establishing said non-transferred contents thus determined as the contents to be transferred to said external device (Col. 7, Lines 57-64, “reinsert this track in the correct location in the tree"), before transferring said non-transferred contents (Col. 1, Lines 25-31, “runs on a host PC and hast playlist feature that allows selection of tracks from the PC’s hard disk”).

As to claim 9, Goodman teaches the information processing method, further comprising the step of acquiring information about albums including said non-transferred contents so that the contents held in the albums identified by the acquired information may be established as the contents to be transferred to said external device (Col. 1, Lines 63-65, “lost songs that are not members of any playlist”).

As to claim 10, Goodman teaches the information processing method, further comprising the steps of: causing displaying means to display information about albums including said non-transferred contents (Col. 1, Lines 60-67, "lost songs that are not members of any playlist"); and given a selection of albums from a user in response to the displayed information (Fig. 10-13, see portable display), transferring the contents from the selected albums ([62], "reinsert this track").

As to claim 11, Goodman teaches the information processing method, further comprising the step of acquiring information about albums having only said non-transferred contents (Col. 1, Lines 40-65, "lost files") so that the contents held in the albums (Fig. 8) identified by the acquired information may be established as the contents to be transferred to said external device (Col. 11, Lines 28-34, "host system...is used to operate the bridge interface to transfer files").

As to claim 12, Goodman teaches the information processing method, further comprising the steps of: causing displaying means to display information about albums having only said non-transferred contents (Col. 10, Lines 45-53, illustrates details of an item on the active queue list...when an album, song, track...is selected"); and given a selection of albums from a user in response to the displayed information (Fig. 12-13), transferring the contents from the selected albums (Fig. 11, see arrow points; Fig. 12, "BEST OF BACH"; Col. 2, Lines 17-29).

As to claim 13, Goodman teaches the information processing method, further comprising the step of acquiring recorded data about said transferred contents from said external device (Fig. 8, see user interface display), before comparing the acquired recorded data about said transferred contents with the content IDS of said contents stored in said data storage block in order to determine non-transferred contents (Col. 4, Lines 15-26).

As to claim 15, Goodman teaches a computer program for carrying out a procedure for transferring contents to an external device (Fig. 14), said procedure comprising the steps of: detecting said external device upon connection thereof ( ); acquiring recorded data including content IDS about the contents already transferred from an information processing apparatus to said external device (Fig. 7 and 13); comparing said recorded data about the transferred contents with the content IDS of said contents stored in a data storage block of said information processing apparatus in order to determine non-transferred contents (Col. 7, Lines 45-55, "build the in-memory memory tree...add track to category..."); and establishing said non-transferred contents thus determined as the contents to be transferred to said external device (Fig. 14), before transferring said non-transferred contents (Col. 2, Lines 39-50, "play back of songs from a hard disk...playbck of music from a radio receiver built into the device...playback of voice messages")

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Jennery et al, (US 2003/0105847), hereinafter Jennery.

As to claim 7, Goodman teaches the information processing apparatus, wherein said data processing block stores said recorded data about said transferred contents (Fig. 14, bidirectional

arrow between items 302 and 300) into a memory of said information processing apparatus and (Fig. 14, item 300).

However, Goodman does not expressly teach based on external device identification information acquired from said external device, extracts recorded data entries about the transferred contents corresponding to said external device from said recorded data about said transferred contents stored in said memory; said data processing block further comparing the extracted recorded data about the transferred contents with the content IDS of said contents stored in said data storage block in order to determine non-transferred contents.

Jennery teaches based on external device identification information acquired from said external device ([43], "machine ID of network device...alow different version of message structure...to be distinguished from each other"), extracts recorded data entries about the transferred contents corresponding to said external device from said recorded data about said transferred contents stored in said memory (Fig. 5, item 64, "signature...version...id...filename"; Fig. 7); said data processing block further comparing the extracted recorded data about the transferred contents with the content IDS of said contents stored in said data storage block in order to determine non-transferred contents ([40], "version information...date/time.../file checksum").

Goodman and Jennery are analogous art pertinent to the problem to be solved. A skilled artisan would have been motivated to combine Goodman and Jennery because it provides for trigger data includes identification information for identifying the network device as discussed in Jennery, Abstract.

Therefore at the time of invention, it would have been obvious to a person having ordinary skill in the art to combine Goodman and Jennery because it provides for trigger data includes identification information for identifying the network device as suggested in Jennery, Abstract.

This combination has the added advantage of facilitating network device update instructions.

As to claim 14, this is analyzed and discussed in claim 7 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Wong whose telephone number is (571) 270-1015. The examiner can normally be reached on Mondays through Fridays from 10 AM – 6PM.

Applicant initiated interviews may be formally requested in advance by faxing a completed PTO-413A form to the examiner's personal fax number at (571) 270-2015. Form PTO-413A is used by the examiner to prepare for any proposed interview. A detailed agenda listing should be attached including any proposed claim language and/or arguments that will be presented. This form is used to determine whether any proposed interview would advance prosecution and fit within a prescribed time limit.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JOSEPH D. WONG /JDW/
Asst. Examiner, Art Unit 2166
17 November 2008

/Khanh B. Pham/

Primary Examiner, Art Unit 2166